



JJGJr.: 08-02

Paper 9

KURT G BRISCOE
NORRIS MCLAUGHLIN
& MARCUS, PA
30th FLOOR
220 EAST 42nd STREET
NEW YORK, NY 10017

COPY MAILED

AUG 19 2002

OFFICE OF PETITIONS

In re Application of
Gers-Barlag, et al.
Application No. 09/265,779
Filed: 10 March, 1999
Attorney Docket No.: Beiersdorf 416.2-KGB

ON PETITION

This is a decision on the pleadings filed on 20 September, 2001, and styled "Renewed Petition to Withdraw Holding of Abandonment," seeking to overturn the 17 July, 2001, decision of the Group Director, and considered, *inter alia*, under 37 C.F.R. §1.181.¹

Unfortunately, the pleadings were not matched with the file until this writing. The Office regrets the delay in addressing this matter.

For the reasons set forth below, the petition under 37 C.F.R. §1.181 to overturn the Group Director's 17 July, 2001, decision (responding to a 26 March, 2001, petition) is **DISMISSED**.²

NOTES: (1) This is the second consideration of issues addressed in the 26 March and 20 September, 2001, petitions. Therefore, there will be no further reconsideration on petition.

¹ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * * (Emphasis supplied.)

² Pursuant to Petitioner's authorization, the cost of the instant petition is charged to Deposit Account 14-1263.

- (2) Moreover, it appears that Petitioner's only alternative for relief is by petition to revive the application as unintentionally abandoned under the provisions of ¶(b) of 37 C.F.R. §1.137.³

Petitioner's failure to seek such relief in a timely fashion⁴ may be considered intentional delay, which is an absolute bar to revival.⁵

³ The regulations at 37 C.F.R. §1.137 provide in pertinent part:

§ 1.137 Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

(b) *Unintentional*. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(c) *Reply*. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(d) *Terminal disclaimer*.

(1) Any petition to revive pursuant to this section in a design application must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any petition to revive pursuant to this section in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of:

- (i) The period of abandonment of the application; or
- (ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed.

(2) Any terminal disclaimer pursuant to paragraph (d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed before June 8, 1995, or a continuing design application, that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought.

(3) The provisions of paragraph (d)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to lapsed patents, or to reexamination proceedings.

[47 Fed. Reg. 41277, Sept. 17, 1982, effective Oct. 1, 1982; para. (b) 48 Fed. Reg. 2713, Jan. 20, 1983, effective Feb. 27, 1983; paras. (a) - (c), paras. (d) & (e) added, 58 Fed. Reg. 44277, Aug. 20, 1993, effective Sept. 20, 1993; para. (c) revised, 60 Fed. Reg. 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Sept. 8, 2000; revised, 65 Fed. Reg. 57024, Sept. 20, 2000, effective Nov. 29, 2000]

⁴ The test of diligence in the prosecution of an application before the Commissioner is, in the context of ordinary human affairs, the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

⁵ That an applicant may have been preoccupied with other matters that took precedence over the revival of an abandoned application is not viewed as an adequate justification for delay. See *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Rather, the revival of an application that was not intentionally abandoned is the applicant's "most important business." See *Ex parte Pratt*, 1887 Dec. Comm'r Pats. 31, 32-33 (1887). Specifically, an applicant seeking revival of an abandoned application is expected to file a petition under 37 C.F.R. §1.137 within two to three months of discovering its abandonment. See *In re Kokaji*, 1 USPQ2d 2005, 2007 (Comm'r Pats. 1986); see also Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53161, 1203 *Off. Gaz. Pat. Office* at 88-89 (response to comment 65).

BACKGROUND

A review of the record reveals:

- the instant application (Application No. 09/265,779 (the '779 application) was filed on 10 March, 1999, as a divisional application of the parent Application No. 08/788,147 (the '147 application), which then issued as a Patent No. 5,968,483 (the '483 patent) on 19 October, 1999;
- contemporaneously with the '779 application Petitioner filed a preliminary amendment, and on 22 June, 1999, the Examiner issued a non-final Office action rejecting pending claims 7 - 12, and setting out a three- (3-) month shortened statutory period (SSP) for reply;
- Petitioner at first contended that he then-intended to file (via U.S. Postal Service (USPS) Express Mail, Label No. EE559518099US) into the '779 application a continued prosecution application (CPA) with a request and fee for a three- (3-) month extension of time, however:

--even on this now second consideration of Petitioner's demand for the withdrawal of the holding of abandonment, Petitioner has failed to submit a copy of the date-stamped USPS Express Mail Label No. EE559518099US evidencing receipt thereof by the USPS;

--consecutive multiple searches of the USPS Tracking system and the Office Express Mail database evidence no record of receipt for transmittal by the USPS of a such-numbered item, nor its receipt by the Office;

--while Petitioner contends intended to file the materials in question into the '779 application, the copies of the papers submitted by Petitioner clearly show that if they were submitted--a contention now certainly in question--he attempted to file the papers not into the '779 application but into the '147 application (then-no-longer pending but having issued as the '483 patent);⁶

- when no proper and timely response was filed, the instant '779 application went abandoned after midnight 22 September, 1999;
- Notice of Abandonment was mailed on 16 March, 2000;
- while Petitioner contends that:

⁶ Even the "Notice of Change of Firm Name" alleged to have been filed by Petitioner on 22 December, 1999, contained the incorrect '147 application number. However, as demonstrated by the lack of documentary proof of submission, it appears not unlikely that even this erroneous notice never was mailed by Petitioner.

--he received the Notice of Abandonment on 20 March, 2000, and submitted via FAX on 21 March, 2000, copies of the alleged 22 December, 1999, filing; and

--he then submitted a written 29 August, 2000, Status Inquiry and made telephone inquiries on 24 October, 2000, and 6 February, 2001,

the record clearly demonstrates that notwithstanding Petitioner's contentions, Petitioner's written inquiry was made not into the instant '779 application but into the already issued '147 application (now the '483 patent).

- through his first petition to the Group Director and now this second petition seeking to overturn the decision of the Group Director, Petitioner has contended that the Office failed to follow its procedures as set forth in MPEP §201.06(d).⁷

⁷ The commentary at MPEP §201.06(d) provides in pertinent part:
201.06(d) 37 C.F.R. 1.53(d) Continued Prosecution Application (CPA) Practice

IN GENERAL

In addition to the provisions of 37 C.F.R. 1.53(b), a continuation or divisional (but not a continuation-in-part) application may be filed under 37 C.F.R. 1.53(d) if the prior application is: (A) a utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, and is complete as defined by 37 C.F.R. 1.51(b); (B) a design application that is complete as defined by 37 C.F.R. 1.51(b); or (C) the national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000, and is in compliance with 35 U.S.C. 371. Applicant may wish to consider filing a request for continued examination (RCE) under 37 C.F.R. 1.114 for utility or plant applications filed on or after May 29, 2000. See MPEP § 706.07(h). A continuation or divisional application filed under 37 C.F.R. 1.53(d) is called a "Continued Prosecution Application" or "CPA." A CPA has a number of advantages compared to a continuation or divisional application filed under 37 C.F.R. 1.53(b).

CONDITIONS FOR FILING A CPA

A continuation or divisional application may be filed under 37 C.F.R. 1.53(d), if the prior nonprovisional application is: (A) a utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, and is complete as defined by 37 C.F.R. 1.51(b); (B) a design application that is complete as defined by 37 C.F.R. 1.51(b); or (C) the national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000, and is in compliance with 35 U.S.C. 371. The term "prior nonprovisional application" in 37 C.F.R. 1.53(d)(1) means the nonprovisional application immediately prior to the CPA. A complete application as defined by 37 C.F.R. 1.51(b) and a "national stage of an international application in compliance with 35 U.S.C. 371" must each contain, *inter alia*, the appropriate filing fee and a signed oath or declaration under 37 C.F.R. 1.63. In addition, a continuation or divisional application filed under 37 C.F.R. 1.53(d) must be filed before the earliest of: (A) payment of the issue fee on the prior application, unless a petition under 37 C.F.R. 1.313(c) is granted in the prior application; (B) abandonment of the prior application; or (C) termination of proceedings on the prior application.

INITIAL PROCESSING

A CPA request will be initially processed by the TC assigned the prior application. The TC will verify that (A) the prior application is a utility or plant application or a national stage of an international application filed before May 29, 2000, or is a design application, (B) the correct application number of the prior nonprovisional application is identified in the request, (C) the request is properly signed, (D) the prior nonprovisional application was pending on, and that the issue fee has not been paid in the prior non-provisional application on or prior to, the filing date of the CPA request, (E) the prior nonprovisional application was complete under 37 C.F.R. 1.51(b) (e.g., the filing fee has been paid and a signed oath or declaration under 37 C.F.R. 1.63 has been filed in the prior application), and (F) the proper filing fee has been paid in the CPA. If a CPA request of a utility or plant application or a national stage of an international application that was filed on or after May 29, 2000 is filed, the CPA is improper and will automatically be treated as a request for continued examination (RCE) under 37 C.F.R. 1.114, see MPEP § 706.07(h), paragraph IV. If one or more other conditions for filing a CPA have not been satisfied or the proper filing fee has not been paid, the applicant will be so notified and no examination will be made in the CPA until the filing error has been corrected or the proper filing fee submitted. See 37 C.F.R. 1.53(h). If an examiner discovers that an improper or incomplete CPA has been forwarded to the examiner in error, the application should be immediately returned to a supervisory applications examiner (SAE) within the TC. The improper or incomplete CPA is not to be returned to OIPE.

INCORRECT PARENT APPLICATION NUMBER IDENTIFIED

A request for a CPA must identify the prior nonprovisional application (37 C.F.R. 1.53(d)(2)(i)) by application number (series code and serial number) or by serial number and filing date. Where a paper requesting a CPA is filed which does not properly identify the prior nonprovisional application number, the TC should attempt to identify the proper application number by reference to other identifying information provided in the CPA papers, e.g., name of the inventor, filing date, title of the invention, and attorney's docket number of the prior application. If the TC is able to identify the correct application number of the prior application, the correct application number should be entered in red ink on the paper requesting the CPA and the entry should be dated and initialed. If the TC is unable to identify the application number of the prior application and the party submitting the CPA papers is a registered practitioner, the practitioner may be requested by telephone to supply a letter signed by the practitioner providing the correct application number. If all attempts to obtain the correct application number are unsuccessful, the paper requesting the CPA should be returned by the TC to the sender where a return address is available. The returned CPA request must be accompanied by a cover letter which will indicate to the sender that if the returned CPA request is resubmitted to the U.S. Patent and Trademark Office with the correct application number within two weeks

STATUTES, REGULATIONS AND ANALYSIS

Congress has provided at 35 U.S.C. §(6)(a), in pertinent part, that:

The Commissioner . . . may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

The regulations at under 37 C.F.R. §1.181 provide a route for relief if there is a proper showing that relief should be granted.

More than 35 years ago the Court of Customs and Patent Appeals warned practitioners in Lorenz v. Finkl⁸ that “ordinary prudence” demands that they take “appropriate action” as directed by the Office, and practitioners disregard this warning at peril to their client's matters.

As discussed above, the record at present fails to satisfy the basic Pratt showing required herein.

Moreover, the courts have determined the construct for properly supporting an a request to withdraw a holding of abandonment.⁹

Because Petitioner has failed now on two occasions to provide documentary support of his position--and in fact it appears that there are no records that can or will do so--Petitioner's argument can have no basis in fact, thus no basis in law, and must be found unpersuasive.

As is clear, Petitioner fails to satisfy the burdens set forth in Delgar v. Schulyer.

ALTERNATIVE VENUE

Lacking the ability to support a petition under 37 C.F.R. §1.181 requiring the withdrawal of the holding of abandonment, Petitioner's only alternative to irretrievable abandonment is to:

of the mail date on the cover letter, the original date of receipt of the CPA request will be considered by the U.S. Patent and Trademark Office as the date of receipt of the CPA request. See 37 C.F.R. 1.5(a). A copy of the returned CPA request and a copy of the date-stamped cover letter should be retained by the TC. Applicants may use either the Certificate of Mailing or Transmission procedure under 37 C.F.R. 1.8 or the “Express Mail” procedure under 37 C.F.R. 1.10 for resubmissions of returned CPA requests if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned CPA request is not resubmitted within the two-week period with the correct application number, the TC should cancel the original “Office Date” stamp on the CPA request and re-stamp the returned CPA request with the date of receipt of the resubmission or with the date of deposit as “Express Mail” with the United States Postal Service, if the CPA request is resubmitted under 37 C.F.R. 1.10. Where the CPA request is resubmitted later than two weeks after the return mailing by the U.S. Patent and Trademark Office, the later date of receipt or date of deposit as “Express Mail” of the resubmission will be considered to be the filing date of the CPA request. The two-week period to resubmit the returned CPA request is not extendible. See 37 C.F.R. 1.5(a). In addition to identifying the application number of the prior application, applicant is urged to furnish in the request for a CPA the following information relating to the prior application to the best of his or her ability: (A) title of invention; (B) name of applicant(s); and (C) correspondence address. See 37 C.F.R. 1.53(d)(8).

⁸ Lorenz v. Finkl, 142 USPQ 26, 27-28 (CCPA 1964).

⁹ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

- file a petition (with fee) and proper reply under 37 C.F.R. §1.137(b), and
- state therein that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional."

CONCLUSION

For the foregoing reasons, withdrawal of the holding of abandonment is not appropriate and the petition of 20 September, 2001, under 37 C.F.R. §1.181, seeking to overturn the decision of the Group Director must be and hereby is **dismissed**.

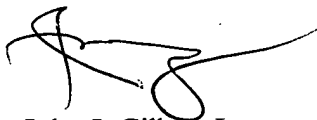
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy